UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/379,589	08/24/99	ROBERTS	D 1364.1001D5/

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LM02/1213

EXAMINER	
VU, V	
ART UNIT	PAPER NUMBER
2758	4

DATE MAILED: 12/13/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/379,589	Roberts et al
Examiner	**Group Art Unit**
V. Vu	2758

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE — 3 — MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 8/24/99.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 2-70 is/are pending in the application.

Of the above claim(s)____ is/are withdrawn from consideration.

☐ Claim(s)____ is/are allowed.

☒ Claim(s) 2-70 is/are rejected.

☐ Claim(s)____ is/are objected to.

☐ Claim(s)____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other____

Office Action Summary

DETAILED ACTION

1. This office action responds to applicant's preliminary amendment filed 8/24/1999. Claim 1 has been canceled. New claims 2-70 have been added.

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Art Rejections:

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 2-6, 16-19, 22, 27-28, 31-32, 35-38, 41, 43-47, 54-57, 62-63 and 65-70 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Kaplan, U.S. pat. No. 5,963,916.

Kaplan discloses a method and system for collecting use data at a local computer during playback of recording material downloaded from a remote server comprising the steps of:

(a) collecting user demographic data and other use data associated with the pre-recording material (e.g., albums/tracks/segments, etc.,) that is downloaded and played/viewed by the user (see col 10, lines 62-65 and col 15, lines 54-63),

(b) transferring the collected data from the local station to the server via a network (see col 7, lines 55-60),

(c) providing complimentary data to user based on the collected use data (see col 16, lines 6-18).

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and

invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

7. Claims 7-15, 20-21, 23-26, 29-30, 39-40, 42, 48-53, 58-61 and 64 are rejected under 35 U.S.C. § 103 as being unpatentable over Kaplan and further in view of Dedrick, U.S. pat. No. 5,710,884.

Kaplan's teachings are still applied as discussed above. Kaplan does not teach monitoring particular user activity during the session, i.e., the length, frequency, etc. Such user activity monitoring for use of marketing purpose is well-known in the art as disclosed by Dedrick (see Dedrick's col 5, lines 17-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Kaplan with Dedrick's teachings of data monitoring because it would have enabled the host to compile a more complete user profile for use by advertisers.

Conclusion:

8. The references cited by the examiner on PTO-892 but not relied upon are considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is (703) 305-9597. The examiner can normally be reached on Monday through Friday from 8:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

VIET D. VU
PRIMARY EXAMINER

Art Unit 2758
12/3/99